

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER T. DIETZ

Appeal 2006-2318
Application 09/591,584
Technology Center 1700

Decided: November 13, 2006

Before GARRIS, WARREN, and WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's final rejection of claims 1 through 15, 17 through 22, 31 through 33, 35, 38, 39, 41 and 42. The Examiner has indicated that the remaining claims in this application are either allowed (claims 24-27, 34, and 40) or objected to as allowable but depending on a previously rejected base claim (claims 16, 23, 30, 36, and 37) (Br. 1). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to Appellant, the invention is directed to a laminate attached to window glass to provide a vehicular or architectural glazing element which has reduced spall and lacerative consequences on impact fracture of the window glass (Br. 2-3). Independent claim 1 is illustrative of the invention and is reproduced below:

1. A laminate attached to window glass suitable for use in a vehicular or architectural glazing element which has reduced spall and lacerative consequences on impact fracture of the window glass; said laminate comprising:
 - (a) a first lamina comprised of visible light transmissive flexible nonadhesive polymeric material having a first major surface and an opposite second major surface;
 - (b) a scratch-resistant layer over said first major surface to provide an exposed surface to the laminate;
 - (c) at least one additional lamina comprised of visible light transmissive flexible nonadhesive polymeric material;
 - (d) a sufficient number of layers of in situ visible light transmissive pressure sensitive adhesive layers to bond said laminae together with the scratch-resistant layer exposed; and
 - (e) a layer of in situ visible light transmissive ambient temperature attachable pressure sensitive adhesive to bond said laminate to window glass, wherein the total thickness of the laminate exceeds about 5 mils and the laminate exhibits a light transmittance.

The Examiner has relied upon the following references as evidence of obviousness:

Murphy	US 4,157,417	Jun. 05, 1979
Hutchinson	US 5,118,540	Jun. 02, 1992
Bilkadi	US 5,677,050	Oct. 14, 1997

Yang	US 6,013,722	Jan. 11, 2000
Tanaka	US 6,033,785	Mar. 07, 2000

The following rejections are before this merits panel for review in this appeal:

- (1) claims 1-5, 7-9, 11, 13, 17-21, 31-33, 38, 39, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hutchinson in view of Murphy (Answer 3);¹
- (2) claim 10 stands rejected under § 103(a) over Hutchinson in view of Murphy and Tanaka (Answer 5);
- (3) claim 6 stands rejected under § 103(a) over Hutchinson in view of Murphy and Bilkadi (Answer 6);
- (4) claims 14, 15, 22, and 35 stand rejected under § 103(a) over Hutchinson in view of Murphy and Yang (*id.*); and
- (5) claims 12 and 42 stand rejected under § 103(a) over Hutchinson in view of Murphy and Bilkadi (Answer 7).²

Based on the totality of the record, including due consideration of the Decision in the first appeal in this application (Appeal No. 2005-0244, with the Decision entered Jan. 28, 2005, hereafter the “prior Decision”), Appellant’s arguments, the Specification, claims, and the prior art of record, we AFFIRM all rejections on appeal essentially for the reasons stated in the

¹ We refer to and cite from the Answer dated Jan. 23, 2006. However, this rejection has been corrected by the Examiner to include claim 41 (*see* the Supplemental Examiner’s Answer dated Feb. 23, 2006). We note that claim 40 has been allowed, and therefore was mistakenly included in this rejection as set forth in the Final Office Action dated June 22, 2005, page 2, and the Brief, page 5.

² This rejection has been corrected by the Examiner to include claim 42 (*see* the Supplemental Examiner’s Answer dated Feb. 23, 2006).

Answer, the Decision in Appeal No. 2005-0244, as well as those reasons set forth below.

OPINION

A. The Rejection over Hutchinson and Murphy

The Examiner finds that Hutchinson discloses a reflective film mounted on a substrate having the following layers: a protective fluorocarbon film, a first layer of pressure sensitive adhesive (hereafter PSA), a silver layer, a biaxially oriented polyethylene terephthalate (hereafter PET), a second layer of a PSA, another layer of a biaxially oriented PET, a third layer of PSA and a support structure (Answer 3; prior Decision, page 4). The Examiner further finds the claimed laminate thickness would have been suggested by Examples 5, 7, and 8 of Hutchinson (Answer 3-4). The Examiner finds that the thin silver film taught by Hutchinson does not necessarily cause the laminate to be completely non-transmissive to visible light but rather reduces the visible light transmittance of the laminate (Answer 4). Since the Examiner construes the claims as “unspecific about the percentage of visible light transmission,” the Examiner finds that Hutchinson “reads on” the claim limitation that the laminate exhibits “a light transmittance” (*id.*; *see* claim 1 on appeal, last line).³

The Examiner recognizes that Hutchinson does not specifically disclose that the reflective film is attached to window glass as required by the claims on appeal (Answer 4). The Examiner finds that Murphy teaches a similar reflective film attached to window glass to reduce the heat and glare

³ We note that claims which recite that the laminate has a light transmittance of at least about 75% have been allowed by the Examiner (e.g., *see* claim 24).

of solar radiation (*id.*). From these findings, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of Appellants' invention to employ the reflective film of Hutchinson with a support structure of window glass to reduce heat and glare from solar radiation, as taught by Murphy (*id.*).

Appellant notes that claims 1 and 9 were amended after the first appeal to differentiate over Hutchinson, namely to recite that the window glass is suitable for use or as a part of a vehicular or architectural glazing element while Hutchinson has no need for a window glass support since solar radiation is not intended to pass through the reference structure (Br. 6-7). Appellant argues that it is improper for the Examiner to ignore the limitation in claims 1 and 12 that the laminate is "suitable for use in a vehicular or architectural glazing element" (Reply Br. 3, 6). Appellant also argues that the Examiner has ignored the positive recitations in claims 9, 41 and 42 of "[a] vehicular or architectural glazing element" (Reply Br. 2-3).

Appellant's arguments are not persuasive. We determine that the Examiner has not ignored the limitations of the claims (Answer 9-10). As correctly noted by Appellant and the Examiner, the only difference between claim 1 on appeal and claim 1 in the prior Decision (Appeal No. 2005-0244) is the limitation that the laminate is "suitable for use in a vehicular or architectural glazing element" (Br. 7; Answer 9). The determination of the effect of preamble language is but a part of the broader task of claim construction. *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 621, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Language in a claim preamble acts as a claim limitation only when such language serves to "give meaning to a claim and properly define the

invention,” not when the preamble merely states a purpose or intended use of the invention. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). “[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Here we determine that the body of claim 1 defines a structurally complete laminate, and the preamble language only serves to state the intended use of the laminate. Therefore we construe claim 1 on appeal as being the same or identical scope of claim 1 in Appeal No. 2005-0244, and adopt the findings and conclusions of law regarding claim 1 as noted in the prior Decision in Appeal No. 2005-0244.

We agree with Appellant that claim 9 recites a “vehicular or architectural glazing element” (Br. 7). However, claim 9 merely recites the same laminate and window glass substrate as claim 1 on appeal, and Appellant has not pointed out, in the Specification, any additional elements or components that would be present in a vehicular or architectural glazing element. Furthermore, Appellant has not pointed to any prior art or established that one of ordinary skill in this art would have recognized that additional components would be present in such glazing elements. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.”).

Therefore we determine that the introductory language of claim 9 on appeal does not patentably distinguish over the laminate of Hutchinson as modified by Murphy.

Appellant argues that there is no mention in Hutchinson that a thin layer of silver is characterized by the presence of a spectral window through which visible light passes (Br. 9; Reply Br. 7). Although Appellant admits that Hutchinson teaches that some ultraviolet (UV) light passes through the thin film of silver (Reply Br. 5), Appellant argues that the Hutchinson film functions to reflect visible light in addition to infrared (IR) and UV light while Murphy functions to transmit light while reducing glare (Br. 9, 11; Reply Br. 7). Appellant argues that, contrary to our prior Decision at page 6, Murphy does not provide any disclosure, teaching, or suggestion that would have motivated one of ordinary skill in the art to combine it with Hutchinson (Br. 10). Appellant also disagrees with our prior Decision as to any conclusion that presumes that radiation passes completely through the metal layer of Hutchinson (Reply Br. 10).

Appellant's arguments are not persuasive. Appellant's argument that Hutchinson fails to disclose that visible light passes through the thin layer of silver is not commensurate with the scope with the claims. For example, claim 1 on appeal merely requires that the laminate "exhibits a light transmittance" (claim 1 on appeal, last line). This claim does *not* specify any amount of light transmitted or that the light is restricted to "visible" light. *See In re Morris, supra.* Appellant admits that Hutchinson discloses that some UV light passes through the thin film of silver (Reply Br. 5; *see Hutchinson 8: 60-64*). Furthermore, Hutchinson teaches that some visible light passes through pure silver films (Hutchinson 1:50-59). With regard to

Appellant's argument regarding the opposing functions of Hutchinson and Murphy, and thus the motivation for combining these references, this argument has been adequately discussed in our prior Decision in Appeal No. 2005-0244, and we refer to and adopt the reasoning and remarks from our prior Decision (pages 6-7).

In view of our claim construction discussed above, as well as the reasons stated in the Answer and our prior Decision in Appeal No. 2005-0244, we determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of Appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore we affirm the rejection of claims 1-5, 7-9, 11, 13, 17-21, 31-33, 38, 39, and 41 under § 103(a) over Hutchinson in view of Murphy.

B. The Remaining Rejections

In each of the remaining rejections, the Examiner applies Hutchinson in view of Murphy, as discussed above, with the additional citation of Tanaka against claim 10, Bilkadi against claims 6, 12, and 42, and Yang against claims 14, 15, 22, and 35 (Answer 5-7). We adopt the Examiner's findings of fact and conclusions of law from the Answer and as discussed above.

With regard to the rejection of claim 6, Appellant argues that Bilkadi does not suggest the claimed laminate (Br. 11). This argument is not well taken since Bilkadi has been applied for its teaching of the advantages of using a ceramer coating in combination with a polyacrylic adhesive (Answer 6). We note that Appellant does not dispute this finding.

With regard to the rejection of claim 12, Appellant argues that there is no suggestion or motivation to replace the temporary premask film of Hutchinson with the permanent cured ceramer layer of Bilkadi (Br. 12). This argument is not well taken since, as correctly stated by the Examiner (Answer 12), the rejection does not propose replacing the premask of Hutchinson with the ceramer of Bilkadi.⁴

With regard to the rejection of claims 14, 15, 22, and 35, Appellant argues that Yang fails to provide any motivation or suggestion for the proposed combination, nor does Yang disclose the claimed laminate with a percent haze less than or equal to about 2.0% (Br. 12-13). These arguments are the same arguments made in the prior Appeal, and we adopt our remarks from pages 9-10 of our prior Decision in Appeal No. 2005-0244.

For the foregoing reasons and those stated in the Answer and our prior Decision, we determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence in the above rejections. Based on the totality of the record, including due consideration of Appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Accordingly, we affirm the rejections as set forth above.

C. Summary

The rejection of claims 1-5, 7-9, 11, 13, 17-21, 31-33, 38, 39, and 41 under § 103(a) over Hutchinson in view of Murphy is affirmed. The rejection of claim 10 under § 103(a) over Hutchinson in view of Murphy and Tanaka is affirmed. The rejection of claim 6 under § 103(a) over

⁴ We note that claim 12 on appeal does not require that the laminate exhibit any light transmittance.

Hutchinson in view of Murphy and Bilkadi is affirmed. The rejection of claims 14, 15, 22, and 35 under § 103(a) over Hutchinson in view of Murphy and Yang is affirmed. The rejection of claims 12 and 42 under § 103(a) over Hutchinson in view of Murphy and Bilkadi is affirmed.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

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